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Koichi Sato

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09/06/2006

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EXAMINER

SELBY, GEVELL V

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/665,413

Applicant(s)

SATO, KOICHI

Examiner

Gevell Selby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,7-11,13 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7-11,13,15-20 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 6/15/06 have been fully considered but they are not persuasive. The applicant submits the Niwa reference does not teach a blank photographing mode. The applicant has submitted that there is no reason to combine the Moronaga and Niwa references. The examiner respectfully disagrees.

#### **Examiner's Response:**

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Moronaga reference discloses a blank photographing operation performing processor (see figure 1, element 44) that performs a photographing operation in a blank photographing mode, such that upon, said photographing, said image data is stored in said buffer memory without being stored in a recording medium, when no recording medium is installed in the electronic still camera (see column 12, lines 1-24), when a recording medium without a blank recording area image data is installed in the electronic still camera (see column 11, lines 3-10), and sufficient to store said when a recording medium, having a blank recording area sufficient to store said image data, is installed in the electronic still camera (see column 12, line 63- column 13, line 7), The Niwa reference discloses a blank photographing operation performing processor that performs said photographing operation in said blank photographing mode when said recording medium sensing processor senses that said recording medium is not mounted (see column 10, lines 20-26). It

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would have been obvious to modify Moronaga in view of Niwa, in order to automate the switching between photographing modes, so that operation of the camera is easier for the user.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Niwa reference teaches that its photographing mode prevents image data recording for being interrupted before desired image data is recorded (see column 11, lines 43-45). Adding an automated feature to a camera to make the operation of the camera easier for the user is in the knowledge generally available to one of ordinary skill in the art. Adding an automated feature does not limit the user, but rather proves more freedom and flexibility while ensuring the image data is saved to memory, which is the prime purpose of the Moronaga reference.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**2. Claims 1, 3, 5, 7-11, 13, 15-20, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692.**

In regard to claim 1, Moronaga et al., US 5,956,084, discloses a photographing operation control device for an electronic still camera (see figure 1), comprising:

a volatile buffer memory (see figure 1, element 28 and column 9, lines 44-49) that temporarily stores image data obtained through a photographing optical (see column 9, lines 35-44); and

a blank photographing operation performing processor (see figure 1, element 44) that performs a photographing operation in a blank photographing mode, such that upon, said photographing, said image data is stored in said buffer memory without being stored in a recording medium, when no recording medium is installed in the electronic still camera (see column 12, lines 1-24), when a recording medium without a blank recording area image data is installed in the electronic still camera (see column 11, lines 3-10), and sufficient to store said image data, when a recording medium, having a blank recording area sufficient to store said image data, is installed in the electronic still camera (see column 12, line 63-column 13, line 7),

a recording medium sensing processor that senses whether the recording medium is mounted (see Taniguchi: switch 10-On and column 8, lines 21-23);

a blank recording area sensing processor (see figure 1, element 46) that senses whether a blank recording area exists in the recording medium (see column 10, line 20-22); and

a photographing mode selecting processor (see figure 1 , element 44) that selects one of said blank photographing mode and said normal photographing mode, said photographing mode selecting processor being able to select said blank photographing mode when said recording medium sensing processor and said blank recording area sensing processor sense that the recording medium having the blank recording area is installed in said device (see column 12, line 56 to column 13, line 7).

The Moronaga reference does not disclose comprising:

a volatile buffer memory configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation;

a normal photographing operation performing processor that performs a photographing operation in a normal photographing mode in which, after storing said image data in said buffer memory, said image data is read from said buffer memory and recorded in said recording medium; and

wherein said blank photographing operation performing processor performs said photographing operation in said blank photographing mode when said recording medium sensing processor senses that said recording medium is not mounted.

Niwa, US 6,538,692, discloses comprising:

a buffer memory (figure 6, element 44) configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation (see column 10, lines 37-40); and

a normal photographing operation performing processor (see figure 6, element 40) that performs a photographing operation in a normal photographing mode in which, after storing said image data in said buffer memory, said image data is read from said buffer memory and recorded in said recording medium (see column 10, lines 56-60); and

a blank photographing operation performing processor (see figure 6, element 40) that performs a photographing operation in said blank photographing mode when said recording medium sensing processor senses that said recording medium is not mounted (see column 10, lines 20-26).

It would have been obvious to one of ordinary skill in the art to have been motivated to modify Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, to have

a volatile buffer memory configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation;

a normal photographing operation performing processor that performs a photographing operation in a normal photographing mode in which, after storing said image data in said buffer memory, said image data is read from said buffer memory and recorded in said recording medium; and

a blank photographing operation performing processor that performs a photographing operation in said blank photographing mode when said recording medium sensing processor senses that said recording medium is not mounted, in order to prevent image data recording from being interrupted before the desired

image data is recorded in an external recording medium and to automate the switching between photographing modes, so that operation of the camera is easier for the user.

In regard to claim 3, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 2. Moronaga discloses wherein that the said photographing mode selecting processor comprises a photographing mode set switch (see figure 1, element 13) by which said blank photographing mode is set, and which is provided in a camera body of the electronic still camera (see column 12, lines 56-66).

In regard to claim 5, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 1. Moronaga discloses wherein said blank photographing operation performing processor performs said photographing operation in said blank photographing mode when said blank recording area sensing processor senses that said recording medium has no blank recording area (column 11, line 3-10).

In regard to claim 7, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, a device according to claim 1. Niwa discloses further comprising an image data transfer processor (see figure 6, element 46) that transfers said image data stored in said buffer to the recording medium (see column 10, lines 58-60).

In regard to claim 8, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 7. Niwa discloses wherein said image data transfer processor transfers said image data to the recording medium when said normal photographing mode is set (see column 10, lines 56-60).



In regard to claim 9, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 1. Moronaga discloses further comprising a mode informing processor (see figure 1, element 44) that informs that said blank photographing mode is set (see figure 3B, indication mark 22 and column 12-56-65: the processor displays the indication mark on the internal memory side of the display to indicate blank photographing mode).

In regard to claim 10, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 1. Moronaga discloses further comprising a non-mounting condition informing processor (see figure 1, element 44) that informs that the recording medium is not mounted (see column 10, lines 20-22 and figure 3).

In regard to claim 11, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses a device according to claim 1. Moronaga discloses further comprising a non-existing condition informing processor (see figure 1, element 44) that informs that the recording medium has no blank recording area (see figure 3c, element 63 and column 11, lines 5-10).

In regard to claim 13, Moronaga et al., US 5,956,084, discloses a photographing operation control device for an electronic still camera (see figure 1), comprising:

- a system controller (see figure 1, element 44);

- a volatile buffer memory for temporarily storing image data (see figure 1, element 28 and column 8, lines 40-41);

a photographing mode set switch (see figure 1, element 13) for switching a photographing operation between a normal photographing mode (recording in the external memory) and a blank photographing mode (recording in the internal memory) (see column 9, lines 35-40),

wherein, when said photographing operation is set to said normal photographing mode (see figures 18 A and B) and an image is photographed, said system controller transfers said image data to a recording medium (see column 10, line 61 to column 11, lines 3),

when said photographing operation is set to said blank photographing mode and an image is photographed, said system controller stores image data in said buffer memory and does not automatically transfer said image data to a recording medium (see column 12, line 63 to column 13, line 4),

when a recording medium is installed but does not include a blank recording area sufficient to store image data, said system controller automatically sets said photographing operation to said blank photographing mode (see column 11, lines 3-10).

The Moronaga reference does not disclose comprising:

a volatile buffer memory configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation;

wherein, when said photographing operation is set to said normal photographing mode and an image is photographed, said system controller

temporarily stores image data in said buffer memory and subsequently automatically transfers said image data to a recording medium;

wherein when a recording medium is not installed in said electronic still camera, said system controller automatically sets said photographing operation to said blank photographing mode.

Niwa, US 6,538,692, discloses comprising:

a buffer memory (figure 6, element 44) configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation (see column 10, lines 37-40);

a normal photographing operation performing processor (see figure 6, element 40) wherein, when said photographing operation is set to said normal photographing mode and an image is photographed, said system controller temporarily stores image data in said buffer memory and subsequently automatically transfers said image data to a recording medium (see column 10, lines 56-60);

wherein when recording medium is not installed in said electronic still camera, said system controller automatically sets said photographing operation to said blank photographing mode (see column 10, lines 20-26).

It would have been obvious to one of ordinary skill in the art to have been motivated to modify Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, comprising:

a volatile buffer memory configured to overwrite the image data with subsequent image data obtained from a subsequent photographing operation;

wherein, when said photographing operation is set to said normal photographing mode and an image is photographed, said system controller temporarily stores image data in said buffer memory and subsequently automatically transfers said image data to a recording medium; and

wherein when a recording medium is not installed in said electronic still camera, said system controller automatically sets said photographing operation to said blank photographing mode, in order to prevent image data recording from being interrupted before the desired image data is recorded in an external recording medium and to automate the switching between photographing modes, so that operation of the camera is easier for the user.

In regard to claims 15 and 16, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses the photographing operation control device according to claims 1 and 13 respectively. The Niwa reference discloses wherein, upon a change from the blank photographing mode to the normal photographing mode, image data stored in the volatile buffer memory is transferred to the recording medium (see column 10, lines 27-29).

In regard to claims 17 and 18, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses the photographing operation control device according to claims 1 and 13 respectively. The Niwa reference discloses wherein in the normal photographing

mode, all image data recorded in the recording medium has been transferred to the recording medium from the volatile buffer memory (see column 10, lines 58-60).

In regard to claims 19 and 20, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses the photographing operation control device according to claims 1 and 13 respectively. The Niwa reference discloses wherein repeated photographing operations in the blank photographing mode overwrite image data in the volatile buffer memory without an intervening transfer of the overwritten image data to the recording medium (see column 10, lines 34-40).

In regard to claims 23 and 24, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses the photographing operation control device according to claims 1 and 13 respectively. The Moronaga reference discloses wherein, upon selection of the blank photographing mode, the presence of image data in the volatile buffer memory that has not been transferred to the recording medium is checked and an indication is provided when untransferred image data is present in the volatile buffer memory (see figure 3a, element 12b and column 12, lines 7-13).

In regard to claim 25, Moronaga et al., US 5,956,084, in view of Niwa, US 6,538,692, discloses the photographing operation control device according to claim 1. The Moronaga reference discloses wherein when said recording medium sensing processor senses that said recording medium is not mounted, and said blank photographing operation performing processor performs the photographing operating in the blank photographing mode, the blank photographing operation performing processor

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does not transmit image data stored in the buffer memory to a recording medium when the recording medium is mounted (see column 12, line 63 to column 13, line 7).

*Allowable Subject Matter*

3. Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gevell Selby whose telephone number is 571-272-7369. The examiner can normally be reached on 8:00 A.M. - 5:30 PM (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gvs



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